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09/866,425	05/24/2001	Andrew J. Vilcauskas JR.	Exit:Post1	5992

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EXAMINER	
WASSUM, LUKE S	
ART UNIT	PAPER NUMBER
2177	14

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PPG

Office Action Summary	Application No.	Applicant(s)	
	09/866,425	VILCAUSKAS ET AL.	
	Examiner	Art Unit	
	Luke S. Wassum	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 12 August 2003, has been received, entered into the record, and considered.

2. As a result of the amendment, claims 1, 3-5, 7 and 15 have been amended, claim 14 has been canceled, and new claim 20 has been added. Claims 1-13 and 15-20 are pending in the application.

Priority

3. The Applicants' claim to domestic priority under 35 U.S.C. §119(e), to provisional application 60/207,698, filed 26 May 2000, is acknowledged. Since the subject matter of the parent provisional application encompasses that of the instant application and claims, a priority date of 26 May 2000 is hereby established.

The Invention

4. The claimed invention is drawn to a method of presenting advertisements in a computer system through the use of popunder windows. Alternative claimed embodiments are implemented in other media, such as a PDA, telephone, television and radio.

Specification

5. In view of the amendments to the Specification, the examiner withdraws the pending objections to the Specification.

Claim Objections

6. Claim 7 is objected to because of the following informalities:

Limitation (d) teaches that the post-session platform is opened based on said post-session instructions. This limitation is taught both at lines 10-11 and again at lines 13-14, which is redundant.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 7-13 and 15-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. Regarding independent claims 7 and 15, the specification fails to disclose an explanation as to what exactly "exchanging traffic between the foreground platform and the post-session platform" entails. While the specification mentions exchanging traffic between platforms, it is never disclosed what constitutes said exchanging, and what exactly is exchanged.

Dependent claims 8-13 and 16-19, incorporating the deficiencies of their respective independent claims, are also rejected.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-6 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Regarding independent claims 1 and 20, the newly added limitation "providing a traffic building resource for directing traffic between displays" renders the claim indefinite. It is unclear exactly what this 'providing' step entails, or what exactly constitutes the claimed 'traffic building resource'. The examiner has failed to locate any teaching of such a step or traffic building resource in the specification.

Dependent claims 2-6, incorporating the deficiencies of parent claim 1 are also rendered indefinite, and are rejected accordingly.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 2, 4, 7-12, 15, 17 and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by **Porn Rodeo** ("source code of www.pornrodeo.com, as of 13 October 1999").

15. Regarding claims 1, 2, 4, 7-12, 15, 17 and 20, **Porn Rodeo** teaches a post-session advertising system and method as claimed, comprising the steps of:

a) embedding post-session instructions into a first display (see window.open and window.focus calls on page 1, lines 15-20);

b) displaying a first display in a first interactive media platform in said foreground of said media;

c) initiating a load triggering event;

d) opening a post-session platform in response to said load triggering event in said background of said media;

e) displaying a post-session display on said post-session platform;

f) maintaining said post-session interactive media platform in said background until a viewer driven view triggering event occurs; and

g) bringing the post-session platform to the foreground in response to a view triggering event;

wherein the media is a computer, said first and post-session displays are web sites or web pages, said first and post-session platforms are web browsers, and said load and view triggering events are mouse clicks (see window.open and window.focus calls on page 1, lines 15-20).

16. Claims 1-5, 7-13, 15-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Landsman et al.** (U.S. Patent Application Publication 2003/0004804).

17. Regarding claims 1, 2, 4, 7-12, 15, 17 and 20, **Landsman et al.** teaches a post-session advertising system and method as claimed, comprising the steps of:

a) embedding post-session instructions into a first display (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B);

b) displaying a first display in a first interactive media platform in said foreground of said media;

c) initiating a load triggering event;

d) opening a post-session platform in response to said load triggering event in said background of said media;

e) displaying a post-session display on said post-session platform;

f) maintaining said post-session interactive media platform in said background until a viewer driven view triggering event occurs; and

g) bringing the post-session platform to the foreground in response to a view triggering event;

wherein the media is a computer, said first and post-session displays are web sites or web pages, said first and post-session platforms are web browsers, and said load and view triggering events are mouse clicks (see paragraphs 3, 16, 17, 36-38, 87, 95, 107 and 109).

18. Regarding claims 3, 5, 13, 16 and 18, **Landsman et al.** additionally teaches a post-session advertising system and method wherein the system logs the duration of the display of the post-session window in the foreground (see paragraph 50).

19. Claims 1, 2, 4, 6-12, 15, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by **Judson** (U.S. Patent 5,737,619).

20. Regarding claims 1, 2, 4, 5-12, 15, 17 and 20, **Judson** teaches a post-session advertising system and method as claimed, comprising the steps of:

a) embedding post-session instructions into a first display (see claimed embedded post-session instructions, Figures 6 and 7);

b) displaying a first display in a first interactive media platform in said foreground of said media;

c) initiating a load triggering event;

d) opening a post-session platform in response to said load triggering event in said background of said media;

e) displaying a post-session display on said post-session platform;

f) maintaining said post-session interactive media platform in said background until a viewer driven view triggering event occurs; and

g) bringing the post-session platform to the foreground in response to a view triggering event;

wherein the media is a computer, said first and post-session displays are web sites or web pages, said first and post-session platforms are web browsers, and said load and view triggering events are mouse clicks (see col. 2, lines 1-4 and 35-50; see also 8, line 54 through col. 9, line 10; see also col. 9, line 27 through col. 10, line 27; see also the last limitation of claim 1, col. 10, lines 50-56).

21. Regarding claims 6 and 19, **Judson** additionally teaches a post-session advertising system and method wherein said step of opening a post-session platform in response to said load triggering event is foregone if a predetermined time period has not elapsed (see discussion of a built-in fixed time delay between downloading the first hypertext document and the information object(s) associated therewith, col. 9, line 53 through col. 10, line 16, and particularly col. 10, lines 3-9).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

25. Claims 3, 5, 13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Porn Rodeo** ("source code of www.pornrodeo.com, as of 13 October 1999") as applied to claims 1, 2, 4, 7-12, 15, 17 and 20 above, and further in view of **Shaw et al.** (U.S. Patent 5,809,242).

26. Regarding claims 3, 5, 13, 16 and 18, **Porn Rodeo** teaches a post-session advertising system and method as claimed.

Porn Rodeo does not explicitly teach a system and method wherein the system logs the duration of the display of the post-session window in the foreground.

Shaw et al., however, teaches a system and method wherein the system logs the duration of the display of the post-session window in the foreground (see col. 6, lines 20-35; see also col. 16, lines 54-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to log the duration of the display of the post-session window in the foreground, since this information can be used to create billing information to bill advertisers based on advertisements actually viewed (see col. 6, lines 31-35).

27. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Porn Rodeo** ("source code of www.pornrodeo.com, as of 13 October 1999") in view of **Shaw et al.** (U.S. Patent 5,809,242) as applied to claims 3, 5, 13, 16 and 18 above, and further in view of **Judson** (U.S. Patent 5,737,619).

28. Regarding claims 6 and 19, **Porn Rodeo** and **Shaw et al.** teach a post-session advertising system and method as claimed.

Neither **Porn Rodeo** nor **Shaw et al.** explicitly teaches a post-session advertising system and method wherein said step of opening a post-session platform in response to said load triggering event is foregone if a predetermined time period has not elapsed.

Judson, however, teaches a post-session advertising system and method wherein said step of opening a post-session platform in response to said load triggering event is foregone if a predetermined time period has not elapsed (see discussion of a built-in fixed time delay between downloading the first hypertext document and the information object(s) associated therewith, col. 9, line 53 through col. 10, line 16, and particularly col. 10, lines 3-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the above limitation, since such a delay would be advantageous in the situation where a user receives the first hypertext document but then quickly decides to proceed to a URL that is not associated with a link in the document or to link to another URL that does not have an associated information object (see col. 10, lines 3-16).

29. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Landsman et al.** (U.S. Patent Application Publication 2003/0004804) as applied to claims 1-5, 7-13, 15-18 and 20 above, and further in view of **Judson** (U.S. Patent 5,737,619).

30. Regarding claims 6 and 19, **Landsman et al.** teaches a post-session advertising system and method as claimed.

Landsman et al. does not explicitly teach a post-session advertising system and method wherein said step of opening a post-session platform in response to said load triggering event is foregone if a predetermined time period has not elapsed.

Judson, however, teaches a post-session advertising system and method wherein said step of opening a post-session platform in response to said load triggering event is foregone if a predetermined time period has not elapsed (see discussion of a built-in fixed time delay between downloading the first hypertext document and the information object(s) associated therewith, col. 9, line 53 through col. 10, line 16, and particularly col. 10, lines 3-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the above limitation, since such a delay would be advantageous in the situation where a user receives the first hypertext document but then quickly decides to proceed to a URL that is not associated with a link in the document or to link to another URL that does not have an associated information object (see col. 10, lines 3-16).

31. Claims 3, 5, 13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Judson** (U.S. Patent 5,737,619) as applied to claims 1, 2, 4, 6-12, 15, 17, 19 and 20 above, and further in view of **Shaw et al.** (U.S. Patent 5,809,242).

32. Regarding claims 3, 5, 13, 16 and 18, **Judson** teaches a post-session advertising system and method as claimed.

Judson does not explicitly teach a system and method wherein the system logs the duration of the display of the post-session window in the foreground.

Shaw et al., however, teaches a system and method wherein the system logs the duration of the display of the post-session window in the foreground (see col. 6, lines 20-35; see also col. 16, lines 54-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to log the duration of the display of the post-session window in the foreground, since this information can be used to create billing information to bill advertisers based on advertisements actually viewed (see col. 6, lines 31-35).

Response to Arguments

33. Applicant's arguments filed 12 August 2003 have been fully considered but they are not persuasive.

34. The examiner will not address any arguments regarding any of the references' failure to disclose a means of providing a traffic building resource, since the claims incorporating this limitation are currently the subject of a rejection under 35 U.S.C. § 112.

35. The Applicants argue that the **Unicast** references fail to teach the use of a post-session platform maintained in the background.

In response, the examiner points out that the **Landsman et al.** reference (U.S. Patent Application Publication 2003/0004804) teaches that an advertisement is downloaded by a browser (identical to the language used in the Applicants' specification, and corresponding to the claimed

'platform'), and is kept in the background (again, the language is identical to that used by the Applicants) until a user-initiated break in surfing is recognized (analogous to the claimed 'view-triggering event'). As such, the examiner contends that the **Landsman et al.** reference in particular, and the **Unicast** references in general, anticipate the claimed invention.

Furthermore, the examiner points out that under 35 U.S.C. § 102(e) as amended by the AIPA, the §102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper priority or benefit claims to prior U.S. applications under §§ 119(e) or 120 if the prior applications(s) properly supports the subject matter used to make the rejection (see MPEP 706.02(a)).

Since the **Landsman et al.** reference is a continuation of application 09/237,718, filed on 26 January 1999, the reference qualifies as §102(e)-type prior art, and is entitled to a priority date of *at least* 26 January 1999, and possibly 15 May 1998 (the date of the parent application 09/080,165).

36. Regarding the Applicants' arguments that the **McNeirney, Porkaew** and **Tetrode** references merely teach that the Java™ programming language provided the capability to practice the claimed invention, the examiner finds these arguments persuasive. The rejections based on these references have been withdrawn.

37. Regarding the Applicants' arguments that the **Porn Rodeo** reference does not have the purpose of building traffic or increase traffic between parties, these are goals of the claimed invention, and not properly limitations.

As to whether the **Porn Rodeo** references teach a means of advertising, there is no qualification that a web site may not display advertisements for itself; in the view of the examiner, the references certainly qualify as a means for advertising.

38. Regarding the Applicants' arguments that the **Judson** reference (U.S. Patent 5,737,619) teaches a system wherein the information object is displayed in the original platform, and not a second post-session platform, the examiner responds that Judson teaches that some of the information may be broadly construed to cover any and all forms of messages, notices, text, graphics, sound, video, tables, diagrams, applets, and other content, and combinations of any of the above (col. 7, lines 59-64), and can be conveyed aurally, or even to the printer. One of ordinary skill in the art would recognize that such outputs require additional processes (analogous to the claimed platform).

Regarding the argument that the second hypertext document pops up as soon as it is downloaded, there are no limitations in the claims regarding behavior of the system after the display of the post-session display.

39. Regarding the Applicants' arguments that the **LaStrange et al.** reference (U.S. Patent 5,784,058) fails to teach a traffic building resource, means for exchanging traffic between the platforms, or providing a traffic building resource, as was stated previously, these are goals of the system, not properly limitations.

The reference clearly teaches that "a user can follow a link from a first browser page and selectively create a separate second browser window (platform) containing the data corresponding to the link (display) without overwriting the first browser page", col. 2, lines 13-18.

However, regarding the embedding of post-session instructions into the display, the examiner agrees that the functionality taught is a function of the browser (the claimed platform), and not of the HTML document (the claimed display). Thus, the pertinent rejections based on **LaStrange et al.** have been withdrawn.

40. Regarding the Applicants' arguments that the **Allen et al.** reference (U.S. Patent 5,918,239) fails to teach a traffic building resource, means for exchanging traffic between the platforms, or providing a traffic building resource, as was stated previously, these are goals of the system, not properly limitations.

The reference clearly teaches that "a user can follow a link from a first browser page and selectively create a separate second browser window (platform) containing the data corresponding to the link (display) without overwriting the first browser page", col. 2, lines 13-18.

However, regarding the embedding of post-session instructions into the display, the examiner agrees that the functionality taught is a function of the browser (the claimed platform), and not of the HTML document (the claimed display). Thus, the pertinent rejections based on **Allen et al.** have been withdrawn.

41. Similarly, the Roskowski reference (U.S. Patent 6,212,554) fails to teach the claimed embedding step, and so the pertinent rejections based on **Allen et al.** have been withdrawn.

42. Regarding the Applicants' arguments that the Shaw et al. reference (U.S. Patent 5,809,242) fails to teach a traffic building resource, means for exchanging traffic between the platforms, or providing a traffic building resource, as was stated previously, these are goals of the system, not properly limitations.

Conclusion

43. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 703-305-5706. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 703-746-5658.

Customer Service for Tech Center 2100 can be reached during regular business hours at (703) 306-5631, or fax (703) 746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Luke S. Wassum
Art Unit 2177

lsw
August 27, 2003

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100